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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/910,653	07/19/2001	Daniel E. E. Hayes JR.	HAYES-4	2622

7590 04/16/2003

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EXAMINER

PELLEGRINO, BRIAN E

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 04/16/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

N.K

<b>Office Action Summary</b>	Application N .	Applicant(s)	
	09/910,653	HAYES ET AL.	
	Examiner	Art Unit	
	Brian E Pellegrino	3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 February 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 06 February 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.  
     If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
         \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
     a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-943)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other:  |

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## DETAILED ACTION

### *Priority*

This application filed under former 37 CFR 1.60 lacks the necessary reference to the prior application. A statement reading "This is a continuation or a divisional or a continuation-in-part of Application No. 09/901,310, filed 7/9/01." should be entered following the title of the invention or as the first sentence of the specification. Also, the current status of all nonprovisional parent applications referenced should be included.

### *Specification*

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "*The invention provides*," "The disclosure describes," etc.

The abstract of the disclosure is objected to because it is too long and using implied language. Correction is required. See MPEP § 608.01(b).

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-3,6-8,11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen et al. (6087553) in view of Shetty et al. (5323954). Cohen et al. disclose an acetabular component with an outer metal shell having a porous coating thereon and an inner polyethylene bearing. Cohen also discloses the metal for the shell can be a cobalt chrome alloy, col. 5, lines 34-36. It is inherent with a porous coating that it possesses good bone ingrowth properties. However, Cohen does not disclose that the porous coating is a *metal* coating. Shetty et al. teach that a titanium coating can be applied on the surface of a cobalt alloy implant device, col. 1, lines 66,67 and col. 2, lines 1-8. Shetty also teaches the coating provides a corrosion resistant surface, col. 2, lines 16-20. Shetty additionally teaches that titanium alloys can also be applied on the surface of the implant, col. 4, lines 33-35. It would have been obvious to one of ordinary skill in the art to use a titanium or alloy metal coating different than the primary base metal on the implant surface as taught by Shetty with the acetabular shell of Cohen in order to provide a more corrosive resistant implant.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen '553 in view of Shetty '954 as applied to claim 1 above, and further in view of Metzger et al. (6280476). Cohen et al. in view of Shetty et al. is explained supra. However, Cohen as modified by Shetty does not disclose the first metal or the metal contacting the bone as being made of tantalum. Metzger et al. teach that a porous tantalum coating is

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applied to a metal shell, col. 11, lines 10-13. It would have been obvious to one of ordinary skill in the art to substitute tantalum as the porous coating as taught by Metzger with the acetabular implant of Cohen as modified by Shetty in order to provide more radiopaque prosthesis.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen '553 in view of Shetty '954 as applied to claim 1 above, and further in view of Thull et al. (5074881). Cohen et al. in view of Shetty et al. is explained supra. However, Cohen as modified by Shetty does not disclose the first metal or the metal contacting the bone as being made of tantalum alloy. Thull et al. teach that a tantalum alloy coating is applied to a metal shell to roughen and improve tissue ingrowth capabilities to the surface of the implant, col. 5, lines 40-62. It would have been obvious to one of ordinary skill in the art to substitute tantalum alloys as the coating taught by Thull with the acetabular implant of Cohen as modified by Shetty in order to provide a roughened surface and a good tissue ingrowth surface.

Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen '553 in view of Shetty '954 as applied to claim 1 above, and further in view of Bateman et al. (5879404). Cohen et al. in view of Shetty et al. is explained supra. However, Cohen as modified by Shetty do not disclose the second metal or the metal contacting the inner liner is made of steel or zirconium alloys. Bateman teaches the use of metal and polyethylene components for parts of the prosthesis, col. 5, lines 18-21. Bateman also teaches that metals such as steel and zirconium alloys are used in making an acetabular component, col. 3, lines 7-11. It would have been obvious to one

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of ordinary skill in the art to substitute steel or zirconium alloys as taught by Bateman in the implant of Cohen as modified by Shetty in order to provide a harder metal base for greater strength.

### ***Response to Arguments***

Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Horber (WO 98/22049) discloses a metal acetabular shell with a metal cover.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Pellegrino whose telephone number is (703) 306-5899. The examiner can normally be reached on Monday-Thursday from 8am to 5:30pm. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached at (703) 308-2111. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-2708.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

*Brian E. Pellegrino*

Brian E. Pellegrino  
April 11, 2002

TC 3700, AU 3738



Bruce Snow  
Primary Examiner